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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/515,060 02/28/00 JOAO

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EXAMINER

TM02/0328

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FIELDS, K

ART UNIT

PAPER NUMBER

2153

DATE MAILED:

03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/515,060

Applicant(s)
Joao

Examiner
Kenneth Fields

Group Art Unit
2153



☒ Responsive to communication(s) filed on Feb 16, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, 4-7, 9, 11-19, and 21-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 4-7, 9, 11-19, and 21-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houstis et al (*Internet, Education, and the Web*) in view Dunn et al (US 5,721,829).

Houstis discloses an apparatus for providing education services in a computer network environment, comprising a central processing device for processing a request by a remote user to receive educational material, a memory device for storing the educational material; a transmitter for transmitting the educational material to the individual including audio and video information; and a receiver for receiving a request from an individual to receive educational material and for receiving a transmission termination signal from the individual (pgs 27 and 28). The data is inherently one of encoded, marked, digitally encoded, analog encoded, digitally marked, analog marked, time marked, time-stamped and frame numbered. Houstis further discloses an interactive multimedia presentation in which the student controls the flow of the lecture with a point and

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click device (e.g., mouse) and thus inherently a student could review certain educational material more than one time.

Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual.

Dunn discloses a system which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual; wherein the material is marked and a transmitter transmits information regarding the second location to the user; the second location being computed prior to a subsequent transmission, wherein the amount of material re-transmitted is programmably selected (col. 7, line 63 - col. 8, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Houstis with the ability to begin a subsequent transmission by retransmitting a portion of the material previously transmitted to the user as disclosed by Dunn. The rationale is as follows: it would have been desirable to enable a user to start and stop the transmission of material, whereby upon the subsequent transmission the user's memory was

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refreshed by replaying a portion of the material that had been previously transmitted. As Dunn teaches the desirability of retransmitting a portion of the material previously transmitted, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to start and stop a transmission, whereby the start of the subsequent transmission included a portion of the material previously transmitted, thereby refreshing the user's memory.

3. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Houstis et al (*Internet, Education, and the Web*) in view Dunn et al (US 5,721,829) as applied in paragraph 2 above, and further in view of Dwyer et al (*Creating a Virtual Classroom for Interactive Education on the Web*).

Houstis does not disclose a video recording device for video conferencing. Dwyer discloses a distance learning system which utilizes a video recording device for facilitating video conferencing between users (pg. 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the distance learning system of Houstis with a video recording device for facilitating video conferencing between users as disclosed by Dwyer. The rationale is as follows: it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the distance learning system of Houstis with a video recording device for facilitating video conferencing between users, thereby providing the students with the

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option of interacting with each other as well as the professors while a lecture was being conducted.

4. Claims 13, 14, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houstis et al (*Internet, Education, and the Web*) in view Dunn et al (US 5,721,829) as applied in paragraph 2 above, and further in view of Goldberg (*World Wide Web - Course Tool: An Environment for Building WWW-Based Courses*).

Houstis does not disclose the tracking of the student's progress as specifically claimed. Goldberg discloses means for determining whether an individual has progressed through educational material; means for determining whether the individual has submitted assignments; means for determining whether the individual has taken examinations; means for generating a signal which is transmitted to the individual, wherein the signal contains information regarding at least one of a course, lecture or program (pages 12-13); a memory device for storing such information, a processor for processing the request to obtain the individuals's status or progression, wherein data is generated which contains information indicative of the individual's status or progression (quiz results) and a transmitter for transmitting information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the remote education system of Houstis with the ability to track a student's progress as disclosed by Goldberg. The rationale is as follows: it would have been desirable to track a student's work, assignments and examinations in order to give both the instructor and

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student feedback regrading the student's progress. As Goldberg teaches the desirability of monitoring a student's work, assignments and examinations, one of ordinary skill in the art would have been motivated by Goldberg's teaching to provide the remote education system of Houstis with the ability to track the student's progress, thereby providing a system which informed the student and teacher as to the how well the student was performing.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Houstis et al (*Internet, Education, and the Web*) in view Dunn et al (US 5,721,829) as applied in paragraph 2 above, and further in view of Hamalainen et al (*Electronic Marketes for Learning: Educational Brokerages on the Internet*).

Houstis does not disclose a financial transaction being processed by the processor related to the educational material. Hamalainen discloses a distance learning system which has the ability to process financial transactions through a networked computer system (pgs. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the distance learning system of Houstis with the ability to process financial transactions as disclosed by Hamalainen. The rationale is as follows: It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the distance learning system of Houstis with the ability to process financial transactions, thereby enabling students to pay for courses and/or course materials directly through the networked computer system.

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Response to Arguments

6. Applicant's arguments filed 2/16/01 have been fully considered but they are not persuasive.

Applicant asserts on pages 11-12:

“Applicant respectfully submits that the Examiner failed to follow controlling case law by failing to provide any evidence of any teaching, suggestion, or motivation, in *Houstis* or in *Dunn* to support the combination of said references. In *In re Dembiczak*, the Court of Appeals for the Federal Circuit stated ‘Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. (citation omitted). The Court of Appeals for the Federal Circuit also stated that ‘... the showing must be clear and particular.’

Applicant respectfully submits that the Examiner’s statements, in support for his combining of the teaching of *Houstis* and *Dunn*, lacked the clarity and particularity which is required by controlling case law. Applicant further submits that the Examiner’s statements in support for combining *Houstis* and *Dunn* were broad and conclusory and amounted to the Examiner’s utilization of hindsight, which is improper.”

The Examiner maintains the position that *Houstis* and *Dunn* is a proper combination. The instant application is directed to a distance learning system where students can request to view educational material on demand (e.g., video lecture). This enables a student to view the material as his schedule permits. When a student terminates the transmission of educational material, the system marks the location in the material where the student has stopped. At a point later in time, when the student wishes to resume viewing the educational material, the system resumes transmission of the previous material by retransmitting a portion of the material already viewed. This retransmission of a portion of the material enables the student to refresh his/her memory regarding where in the educational material the student had ended the transmission.

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The rejection formulated by the Examiner combines the teachings of Houstis and Dunn to arrive at the claimed invention. Houstis provides a distance learning system where students can request to view educational material on demand (e.g., video lecture). Houstis does not provide the ability for a student to terminate transmission of the educational material and resume by retransmitting a portion of the material. Dunn, however, discloses a video on demand system which allows a user to order entertainment type material over a network. A user is able to choose a particular program to view by ordering the program through a central processor. After the transmission of the program has begun, if the user stops viewing the program, the system marks a point in the program where the user stopped viewing. When the user returns to the channel to resume viewing the program, the system retrieves the unfinished program and is able to roll a portion of the program back to refresh the viewer's memory (column 7, line 34 - column 8, line 11). Specifically, the reference notes:

“The video content playing unit employs the viewer ID and pause point to access the CMS database and retrieve the unfinished program (step 232). At step 234, the program can be optionally rolled back so that a portion of the program is repeated to refresh the viewer with the sequence of events where the viewer last left off. (Column 7, line 65 - column 8, line 3).

To qualify as prior art under 35 U.S.C. 103, art must be analogous. Analogous art is art in the field of the applicant's endeavor or art reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Examiner asserts that Dunn is analogous art and thus can properly be applied in

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combination with Houstis. While applicant's specific field of endeavor may be considered remote education or distance learning, applicant's general field of endeavor is concerned with transmitting multimedia data on demand to remote users. Likewise, Dunn focuses on precisely the same field of endeavor; i.e., transmitting multimedia data on demand to remote users. The difference between the two being that applicant deals with educational material while Dunn deals with entertainment material.

Examiner maintains the position that the combination of Houstis and Dunn is proper. The motivation to combine the references is clear and particular as required by governing case law. Dunn plainly describes the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11). As Dunn teaches the desirability of retransmitting a portion of material previously viewed by a user, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to restart a transmission by retransmitting a portion of the material previously viewed, thereby refreshing the user's memory by reviewing the old material.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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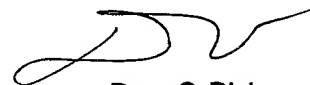
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication of earlier communications from the examiner should be directed to Kenneth Fields whose telephone number is (703) 308-4954.

The fax phone number for this art unit is (703) 305-7201. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the technology center receptionist whose telephone number is (703) 305-3900.



Kenneth Fields
March 22, 2001



Dung C. Dinh
Primary Examiner